

REMARKS

Claims 1-38 are pending in the present application. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of February 24, 2005, the following actions were taken:

- (1) Claims 10, 11, 17, 31, 32, and 38 were objected to as per certain informalities in the claims.
- (2) Claims 4 and 25 were rejected under 35 U.S.C. 112, first paragraph, for failing to enable any person skilled in the art to make the invention commensurate in scope with of the claims.
- (3) Claims 34 was rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.
- (3) Claims 1-9, 12-16, 18-30, and 33-37 were rejected under 35 U.S.C. 102(e) as being anticipated by Zimmer et al. (U.S. 6,843,838) hereinafter "Zimmer."

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Claim Objections

Claims 10, 11, 17, 31, 32, and 38 were objected to because of certain claim informalities. The claims have all been amended per the Examiner's instructions and all informalities have been corrected. Therefore, the Applicants request that this objection be withdrawn.

Rejections under 35 U.S.C. 112, first and second paragraphs

The Examiner has rejected claims 4 and 25 under 35 U.S.C. 112, first paragraph and claim 34 under 35 U.S.C 112, second paragraph. Claims 4 and 25 have been amended per the Examiner's recommendation. Claim 34 has been canceled.

Therefore, it is respectfully requested that the rejections of claim 4, 25, and 34 be withdrawn.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-9, 12-16, 18-30, and 33-37 under 35 U.S.C. 102 as being anticipated by Zimmer. According to the face of the Zimmer patent, the 102(e) date is December 31, 2002. The Applicants respectfully provide an affidavit under 37 C.F.R. 1.131 to effectively swear behind the cited reference. See Exhibit 1. The currently submitted affidavit is signed by all available inventors of the present invention and states that the present invention as claimed was invented prior to December 31, 2002. Also enclosed are three consecutive pages from the laboratory notebook of Alexey Kabalnov (also signed by Charles Dupuy), which shows ink-sets and dye sets that are combined as claimed. See Exhibit 2.

The Manual of Patent Examining Procedure § 715.04(D) states that “where a joint inventor is ... otherwise unavailable, the signatures of the remaining joint inventors are sufficient” for an affidavit under 37 C.F.R. 1.131. Inventor Patricia Wang is not included in the presently submitted affidavit because she has left Hewlett-Packard Company and now works for a competitor company in a similar field, and thus, is considered to be “unavailable” for the purposes of the affidavit. However, it is noted that the affidavit is signed by all four of the other named inventors. The Applicants respectfully assert that the correctly filed affidavit overcomes the Examiner’s rejection with respect to these references and requests that all the rejections over the above listed references be withdrawn.

In view of the foregoing, Applicants believe that claims 1-38 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No.08-2025.

Dated this 24 day of June, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "M. Wayne Western", is written over a horizontal line.

M. Wayne Western
Attorney for Applicants
Registration No. 22,788

Gary P. Oakeson
Attorney for Applicants
Registration No. 44,266

Of:

THORPE NORTH & WESTERN, LLP
8180 South 700 East, Suite 200
Sandy, Utah 84070
(801) 566-6633